

Appl. No. 10/820,617
Amdt. Dated October 24, 2006
Reply to Final OA Dated September 11, 2006

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REMARKS

The Final Office Action rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by Walenta (U.S. Patent No. 697,574), and rejected claims 2-5 and 7-10 under 35 U.S.C. § 103(a) as being unpatentable over Walenta. The Examiner has withdrawn his previous Section 112 rejection in light of the Applicant's previous response. While the Applicant vigorously disagrees with these rejections and therefore traverse them, the Applicant has amended independent claims 1, 3, and 5 (and hence all claims that depend from them) to clarify the claims. Applicant believes this overcomes all pending rejections.

I. THE EXAMINER'S 102 REJECTION OF CLAIM 1 IS ERROR.

According to Section 2131.00 of the MPEP, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)." At a minimum, Walenta lacks four critical elements of Claim 1. First, Walenta lacks an inner scoring area. The Walenta game consists of "nine flexible and elastic vertical pillars E" (lines 59-60 and Fig. 1). The Examiner recites that the "Outer Pillars (point values 10, 15, 25) correspond to the recited scoring area. Inner pillar E (point value 100) corresponds to the inner scoring area." However, Claim 1 requires "an inner scoring area having a perimeter." The center pillar (point value 100) lacks a perimeter as required by the claim and therefore does not meet this limitation. Moreover, the Applicant has amended Claim 1 to clarify that the inner scoring area has "a perimeter in which a ball may come to rest." Walenta clearly lacks this limitation as a game ball and inner pillar E cannot occupy the same space at the same time, so it is not possible for the game ball to come to rest in the purported inner scoring area of Walenta.

Second, as clarified in the pending amendment, Claim 1 requires that the playing surface be suitable for supporting the game players while playing the game. According to the Examiner — but disputed by Applicant as explained in detail below — Walenta meets

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the marker limitation by the row of pins H. A game player pitches or rolls a game ball while standing on the playing surface and behind the marker. Claim 1 has been amended to clarify that the playing surface is "suitable for supporting one or more players of the game standing on the playing surface." The playing surface A found in Walenta by the Examiner provides no indication that it would be suitable for supporting the weight of the players or sufficiently stable so that a player could release the top of Walenta or pitch a ball while standing on Walenta's purported playing surface.

Third, Walenta lacks a marker. In fact, the Examiner mistakenly asserts that pins H located in the middle of the game board A comprise a marker. However, that cannot be so because the claim requires "a marker, placed at one end of the playing surface." Pins H are clearly not located at an end of the game table, assuming that qualified as a playing surface. Moreover, the Applicant has amended Claim 1 to clarify that the marker is the point "behind which a player pitches or bowls a game ball." Even if the Examiner was allowed to ignore the playing surface of Walenta that stretches to the left of Pins H, it is beyond dispute that a top in Walenta is released at the left end of the playing surface A, not at pins H. The reason why Walenta lacks a marker is that it is not directed at a ball pitching game. Rather, it uses a top holder D in lieu of a marker to control the initiation by a player of the top C.

Fourth, Walenta lacks game balls for pitching or bowling. Although the Examiner argues that "Balls G are inherently capable of being place[d] on top of the game pole as well as inherently capable of being pitched or bowled at the pillars," this is counterintuitive. As discussed above, Walenta employs a spinning top C, not a game ball, and again according to Walenta, the balls are placed on top of pillars E. Moreover, pillars E located at the front of the game table as well as the top holder D and pins H would obstruct a player attempting to roll or pitch a ball in any event. Thus, Walenta teaches away from using a game ball as the means for a player to initiate game action and score points. Furthermore, for a 102 rejection, all elements of the claim must be present in the cited prior art. Since Walenta discloses no balls for pitching or bowling at the scoring goal, Walenta is not a proper 102 reference.

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Because Walenta lacks all four of these claim elements, it cannot be a basis for rejecting claim 1 under Sections 102 or 103. The Examiner should therefore withdraw this rejection.

II. THE EXAMINER'S 103 REJECTION OF CLAIMS 2-5 AND 7-10 IS ERROR.

As set forth above, this rejection is improper with respect to claim 2 through 10 because Walenta lacks the above four elements. With respect to claim 2, Walenta lacks a playing surface, a marker, an inner scoring area, and game balls. Claims 3 and 4 require "at least three inner poles inserted into the playing surface forming an inner scoring area." Walenta lacks both three inner poles as well as an inner scoring area. Walenta also lacks the marker and game balls recited in these claims.

With respect to claims 5 through 10, Walenta lacks the playing surface, marker, and game balls as well as "four inner poles inserted into the playing surface forming an inner square." It further lacks "an inner boundary formed by the inner poles" as recited in the claims. Additionally, Walenta also lacks a line attached to the outer and inner poles (claim 6), inner poles with different colors (claim 7), game balls with different colors and corresponding markings (claim 8), four game balls all having different colors (claim 9), and scoreboard (claims 2 and 10).

The Examiner's repeated and general reliance on what hypothetical persons of ordinary skill in the art would know is improper. The Office Action employs the knowledge of a hypothetical person of skill in the art to supply several claim elements, including multiple inner pillars, differently colored balls, and differently colored poles. But the Examiner fails to provide any basis for why one would modify the game table of Walenta to include these changes, particular given the fact that Walenta employs a spinning top, not game balls. As Section 2142 of the MPEP explains, "When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986)." The Office Action fails to meet this requirement.

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For the multiple reasons set forth above, the rejections under 103 are in error and should be withdrawn.

III. TO SUSTAIN HIS REJECTIONS, THE EXAMINER MODIFIED WALENTA BASED ON THE "SKILL IN THE ART" YIELDING A NON-SENSICAL RESULT.

Finally, if there was any doubt as to why the Examiner's rejections of Claims 1-5 and 7-10 were error, consideration of the multiple changes suggested by the Examiner to Walenta to meet the limitations of the claims yields a non-sensical result and defies common sense. Walenta discloses a game table having a flat table A enclosed by a rail B. The table is supported by four legs, and appears to stand about 3.5' - 4.5' high based on Figure 1. To play the game, the player stands on the floor next to the game table, spins top C, and releases it onto the game table with the object that top C hit pillars E to knock off balls G and obtain a score based on certain rules. According to the Examiner, the playing surface A of Walenta corresponds to the playing surface required by Claims 1-10. The marker is found at pins H, the outer scoring is found at the pillars E (point values 10, 15, 25), and the inner scoring area is found at pillar E (point value 100).

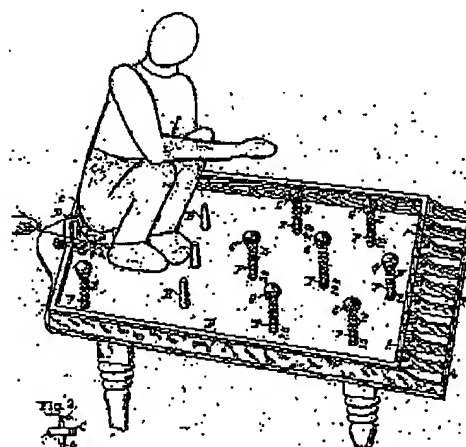
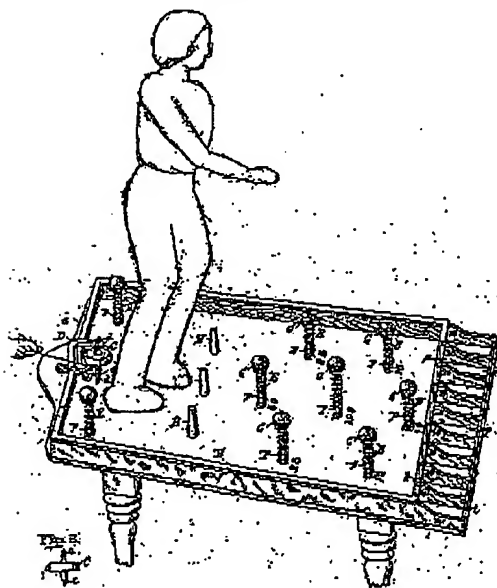
Applying Examiner's logic, to play the game of claims 1-10, a player would take the following steps:

- First, the player would stand on playing surface A of the game table in Walenta. This would require the player to climb on top of the table and stand behind the marker (pins H according to the Examiner). As illustrated in the figures below, this would likely result in an unstable, awkward situation, which would likely result in the game table tipping over.
- Next, the player would pitch or bowl a game ball standing behind pins H at the scoring goal comprised of the pillars E (point values 10, 15, 25, and 100). This would require the player either to squat down to pitch or bowl the game ball while balancing on the table or the player would simply drop the game ball onto playing surface A of the table. See figures below. Based on Figure 1 of Walenta it appears that the scoring goal and the marker (pins

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H) are less than 5' apart, so the player's pitch or bowl would be a very short distance.

- After pitching or bowling the game ball, the player would climb down from the table to allow the next player to climb up onto the table for that player's turn.



Also, to be a proper Section 103 reference, the following modifications would need to be made to the game-top playing table of Walenta: (a) the top C and structure for spinning/releasing the top would need to be replaced to accommodate a player being able to pitch or bowl a game ball (all claims), (b) the pillars E would need to be modified to create inner and outer scoring area (claims 1-2), three inner poles/outer poles (claims 3-4), or an inner boundary/outer boundary (claims 5-10), (c) line attached to inner and outer poles (claim 6), (d) inner poles with different colors (claim 7), (e) game balls would need to be substituted for the top C (all claims), and (f) game balls with different colors would need to be added (claim 9). After making all these changes based on the knowledge of one skilled in the art, there is little left of Walenta, and as demonstrated above, Walenta would fail for its purpose.

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CONCLUSION

The Applicant respectfully requests the Examiner to make the above amendment, withdraw all pending rejections, and allow the patent to issue. Any questions regarding this response should be directed to the undersigned attorney for Applicant.

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